

REMARKS

I. Claim Status

Claims 2-9 are pending in this application following entry of the foregoing amendments. Claim 1 has been canceled without prejudice or disclaimer. Claims 2-7 have been amended to place the claims in proper form for U.S. examination. Claims 8 and 9 have been added. Support for new claims 8 and 9 is found at least in the originally filed specification and claims. In particular, the general subject matter of canceled claim 1 has been newly represented in claims 8 and 9. Accordingly, no new matter has been added by these amendments and no estoppels are intended thereby.

II. Restriction Requirement

The examiner has required restriction under 35 U.S.C. § 121 between the following two groups of claims:

Group I, Claims 2-6, drawn to compounds of Formula (I), classified in various subclasses of classes 514 and 548; and

Group II, Claims 1 and 7 drawn to methods of use of compounds of Formula (I); classified in various subclasses of classes 514 and 548.

The examiner has further required an election of species under 35 U.S.C. § 121 if Applicants elect any of Groups I or II. Applicants respectfully traverse the rejection.

In an effort to be fully responsive, Applicants provisionally elect, with traverse, to prosecute the subject matter of Group I, drawn to compounds and compositions of Formula (I).

Applicants further provisionally elect, with traverse, to prosecute the species of Example 1: 5-(4-chlorophenyl)-1-(2,4-dichlorophenyl)-N-(piperidin-1-yl)-1H-1,2,4-

triazole-3-carboxamide hydrochloride). The specific variables contained in the species of Example 1 are defined as follows: R is 2,4-dichlorophenyl; R₁ is 4-chlorophenyl; and R₂ and R₃ together form the saturated substituent piperidine (piperidin-1-yl). The synthesis of this compound is detailed on pages 6 and 7 of the specification and is specifically identified on page 7.

A restriction requirement is proper when two criteria are met. First, the examiner must establish that an application claims multiple independent or distinct inventions. Second, the requirement for restriction must establish that the search and examination of each of these independent or distinct inventions would constitute a serious burden on the examiner. Moreover, "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. Applicants respectfully submit that the examiner has not shown that these criteria have been met for at least the following reasons.

First, Applicants submit that the originally issued restriction requirement improperly grouped original claims 1-7. Applicants further submit that a proper grouping of the claims wherein the compounds of Formula (I) are separately grouped from the methods of use of compounds of Formula (I) should have grouped claims 2-5 in Group I and claims 1, 6, and 7 in Group II. As originally presented, each of claims 1, 6, and 7 were respectively, directed to use of compounds of Formula (I) for the treatment of disorders involving CB₁ cannabinoid neurotransmission and the use of compounds of Formula (I) for the preparation of a composition for use in the treatment of disorders involving cannabinoid neurotransmission.

In view of Applicants' foregoing amendment canceling and adding claims and Applicants' above remarks, Applicants submit that the originally issued restriction requirement most reasonably corresponds to the more proper grouping of claims 2-5, directed to compounds of Formula (I) and compositions of Formula (I) in Group I, and the grouping of original claims 6 and 7 and new claims 8 and 9, all of which are generally directed to methods of use of the compounds of Formula (I), in Group II. For convenience and efficient furtherance of prosecution, Applicants have respectfully addressed the restriction requirement believed to have been intended by the examiner and have further addressed new claims 8 and 9 in the below remarks.

Applicants further submit that a proper search and examination of the subject matter covered by all of claims 2-9, i.e., compounds of Formula (I), pharmaceutical compositions comprising compounds of Formula (I), a method for making a pharmaceutical composition comprising at least one compound of Formula (I), and a method for treating at least one disorder involving CB₁ cannabinoid neurotransmission comprising administration of at least one compound of Formula (I), would not be unduly burdensome on the examiner as the proper searches significantly, if not entirely, overlap. Specifically, the subject matter of all of the present claims would require the examiner to search for the novel compound of Formula (I). Thus, a search for any of the pending method or composition claims would necessarily involve a search of the claimed compounds of Formula (I).

In view of the foregoing amendments and remarks, Applicants respectfully submit that the examiner has not shown, and moreover cannot show, that the search and examination of all of the subject matter of pending claims 2-9 would constitute an undue

burden. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and should be withdrawn.

Applicants furthermore respectfully request substantive examination of this application and the timely allowance of pending claims 2-9.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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